

REMARKS

Claims 1 to 15 were pending in the application at the time of examination. Claims 1 to 15 stand rejected as obvious.

Claims 1 to 11 stand rejected as being obvious, by U.S. Patent Application Publication No. 2002/0073106 A1, hereinafter referred to as Parker, in view of U.S. Patent No. 6,738,799 B2, hereinafter referred to as Dickenson. In the final rejection, the Examiner stated in part:

As per claims 1 and 5-6, Parker et al. teaches "storing said at least one earlier version of said document in its entirety in a file . . ." (see page 6, paragraphs [0154]-[0157]) "storing said current version of said document in its entirety in said file" (see page 6, paragraphs [0154] (Sic) and page 3, paragraphs [0073]-[0076]). . . . Dickenson teaches "wherein said at least one earlier version and said current version are both in said file for subsequent use" (see col. 3, lines 45-67 and col. 4, lines 1-14).

As the basis for maintaining the rejection, the advisory action stated:

. . . Parker in view of Dickenson teaches applicant's claim language for storing versions of documents in a file. Both Parker and Dickenson teaches the storing of versions of data on files, whereas those files are combinable in manner demonstrated in applicant's claim language.

Applicant respectfully notes that the advisory action provided no citations to either reference to support the comments and so the only basis available is that quoted above from the final office action.

Applicant continues to respectfully traverse the obviousness rejection of Claim 1. Applicant respectfully notes that the MPEP sets out the criteria that must be met in an obviousness rejection. The MPEP requires:

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

MPEP § 2141, 8th Ed., Rev. 2, pp 2100-120 (May, 2004).

Both references show a differential system for maintaining files, Applicant has twice quoted portions of Parker that demonstrates that Parker stores a particular version of a document and a delta for subsequent use. When a different version of the document is requested, the delta and the particular version are used to construct the requested version. Such actions teach nothing about how the requested version and the current version are stored. In particular, the portion cited by the Examiner, e.g., paragraph of 154, teaches how to reconstruct a requested version, but teaches nothing about how the requested version and the other version are stored.

In fact, if the two were stored in any fashion there would be no need to use the delta to reconstruct the version as described by Parker, but Parker explicitly teaches using the delta. Therefore, Parker taken as a whole teaches away from storing two versions in any fashion, because such an interpretation makes the teachings concerning deltas of Parker superficial and unnecessary, e.g., changes the principles of operation of Parker, which is inappropriate in an obviousness rejection.

The citation to Dickenson in the rejection is in the Summary of the Invention. Consideration of the reference as a whole requires that all of Dickenson be considered. When this is done, Dickenson shows the same thing at the same level of specificity as Parker. For example, Fig. 9 of Dickenson shows that a file 901 and a delta file 902 are used to construct a third file 903. The rejection has cited no teaching of how the different versions are stored. The language relied upon is Applicant's claim language. Again, the teaching, taken as a

whole, is using one version and a delta to construct another version. The rejection failed to cite any teaching of how the versions were stored.

Use of a file and a delta file to create another file teaches away from Applicant's invention as recited in Claim 1, because with Claim 1 such a reconstruction is unnecessary. Despite this teaching away, the motivation for the combination in the final rejection was:

It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Dickerson and Parker above, because using the steps "wherein said at least one earlier version and said current version are both in said file for subsequent use" would have given those skilled in the art the tools to store current and earlier versions in an individual file. This gives users the advantage of manipulating the versions of various documents in a more efficient manner.

This motivation cites no teaching in the prior art to support the conclusions and instead uses Applicant's claim language. The MPEP directs:

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION

MPEP § 2143.01, 8th Ed., Rev. 2, pp 2100-129 (May 2004).

The motivation provided is not based on any citation to the prior art and so the rejection has failed to establish that the prior art suggests the desirability of the claimed invention. Accordingly, a proper basis for the motivation has not been established. This is further evidenced by the MPEP requirement:

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

MPEP § 2143.01, 8th Ed., Rev. 2, pp 2100-131 (May, 2004).

The two cited references establish the level of skill in the art and Parker teaches that the motivation is not well founded. In particular, Parker stated:

It is an object of the present invention to use minimum storage on-site and offsite by storing only a baseline version of a document offsite with all forward deltas and saving only the current version of the document on-site with all reverse deltas. The volume and time to transmit data to offsite storage and back to the on-site host is kept to a minimum. (Emphasis added.)

Parker, paragraph [0005]

One of skill in the art in viewing Parker would be looking to use minimum storage. Storing two versions goes against minimizing storage. It also goes against the explicit teaching of storing only a single version and deltas, as discussed above. Accordingly, one of skill in the art, in view of Parker would not have the motivation used in the rejection. This is further evidence that the references have not been considered as a whole.

Applicant has shown that even if the interpretations of the two references were correct, the motivation used for the combination is not well founded and fails to meet multiple requirements of the MPEP. Accordingly, the obviousness rejection is not well founded for multiple reasons, any one of which is sufficient to overcome the rejection. Applicant

requests reconsideration and withdrawal of the obviousness rejection of Claim 1.

Claims 2 to 4 depend from Claim 1 and so distinguish over the combination of references for at least the same reasons as Claim 1. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 4.

With respect to the obviousness rejection of Claim 5, the above comments concerning Parker and Claim 1 are incorporated herein by reference. Also, Paragraph 76 of Parker, as quoted above, describes encrypting both the delta and the file. First, as noted with respect to Claim 1, this teaches away from storing both versions in their entireties. Second, the delta and file are both encrypted which teaches away from storing in different forms as in Claim 5. Accordingly, Claim 5 distinguishes over the combination of references for multiple reasons. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 5.

Claim 6 includes language similar to Claim 1. Thus, the comments above with respect to Claim 1 are directly applicable to Claim 6 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 6.

Claims 7 to 8 depend from Claim 6 and so distinguish over the combination of references for at least the same reasons as Claim 6. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 7 to 8.

Claim 9 includes language similar to Claim 1. Thus, the comments above with respect to Claim 1 are directly applicable to Claim 9 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 9.

Claims 10 to 11 depend from Claim 9 and so distinguish over the combination of references for at least the same reasons as Claim 9. Applicant requests reconsideration and

withdrawal of the obviousness rejection of each of Claims 10 to 11.

Claim 12 includes language similar to Claim 1. Thus, the comments above with respect to Claim 1 are directly applicable to Claim 12 and are incorporated herein by reference. Applicant submits that Claim 12 distinguishes over the combination of references.

Claims 13 to 15 depend from Claim 12 and so distinguish over the combination of references for at least the same reasons as Claim 12. Applicant submits that each of Claims 13 to 15 distinguishes over the combination of references.

Claims 1 to 15 remain in the application. For the foregoing reasons, Applicant respectfully requests allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant.

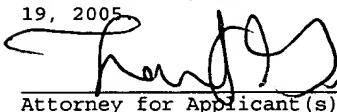
Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 19, 2005.



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Date of Signature